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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,249	02/01/2001	Shin-Ichi Itoh	WN-2298	4330

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EXAMINER

SHAW, JOSEPH D

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,249

Applicant(s)

ITOH, SHIN-ICHI

Examiner

Joseph D Shaw

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4.8.9</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2141

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed September 9th, 2002 and January 28th, 2003 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because no concise statement of relevance and/or English translation have been provided. While the Japanese Office Action included with each information disclosure statement references each of the Japanese documents, these references are merely one line explanations of a limitation taught by the reference, and do not provide the examiner with a sufficient understanding of the Japanese document to consider it relevant. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2141

2. Claims 1, 3-9, 11-14, 16-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. (5,862,202) in view of Stevens (TCP/IP Illustrated).

a. As per claim 1, Bashoura teaches:

a control portion which controls a network by the use of an internet protocol (fax sender sends file to an IP address; col. 4, lines 13-19, 58-65);

a readout portion which reads-out a paper to produce an image data signal (inherent that fax machines scan a paper to send as a data signal);

an operation portion which inputs an Internet protocol address as a transmitting destination of the image data signal (computer provides an IP address for sending the file; col. 4, lines 13-19, 58-65); and

a transmission portion which directly transmits the image data signal to the terminal having the inputted address (received at the remote computer; col. 5, lines 17-25).

However, Bashoura does not explicitly teach using a transmission control protocol to control the network. Stevens teaches that TCP can be used with IP to provide services to the application layer (page 223, 17.2 TCP Services, paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Bashoura invention to include controlling the network by using TCP, as taught by Stevens, because TCP provides a connection-oriented, reliable, byte stream service, as taught by Stevens (17.2 TCP Services, page 223, paragraph 1).

Art Unit: 2141

b. Claims 9, 14, and 18 claim similar limitations to claim 1 and are rejected on the same grounds as claim 1.

c. As per claim 3, Bashoura discloses the claimed invention modified above in claim 1. Furthermore, Bashoura teaches:

the transmission portion transmits the image data signal to the terminal by using e-mail (col. 4, line 66 - col. 5, line 6).

While the modified Bashoura invention makes mention of sending an image data signal to a terminal by using e-mail, no explicit teachings of a simple mail transfer protocol are found. Stevens teaches that the exchange of mail using TCP can be defined by the SMTP protocol (28.1 Introduction, pages 441-442, entire section).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the modified Bashoura invention to include sending data via SMTP, as taught by Stevens, because SMTP is an Internet standard for sending mail, where about one-half of all TCP connections are made for SMTP traffic, as taught by Stevens (28.1 Introduction, page 441, paragraph 1; 28.5 Summary, page 459, paragraph 1).

d. Claims 11, 16, and 20 claim similar limitations to claim 3 and are rejected on the same grounds as claim 3.

e. As per claim 4, Bashoura discloses the claimed invention modified above in claim 1. Furthermore, Bashoura teaches:

Art Unit: 2141

the transmission portion transmits the image data signal to the terminal by using a file transfer protocol (col. 4, lines 13-19, 58-65).

f. Claims 12, 17, and 21 claim similar limitations to claim 4 and are rejected on the same grounds as claim 4.

g. As per claim 5, Bashoura discloses the claimed invention modified above in claim 1. Furthermore, Bashoura teaches:

the terminal comprising any one of a personal computer and a workstation (remote computer; Fig. 1, element 19; col. 5, lines 17-25).

h. As per claim 6, Bashoura discloses the claimed invention modified above in claim 1. However, the modified Bashoura invention does not explicitly teach a plurality of terminals connected to an Ethernet. "Official Notice" is taken that both the concept and advantages of having a plurality of terminals connected to an Ethernet are well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the modified Bashoura invention to include a plurality of terminals connected to an Ethernet because the plurality of terminals could then communicate across the Ethernet, wherein Ethernet is a well-defined IEEE standard for networking hardware and is the predominate form of local area network technology used with TCP/IP.

Art Unit: 2141

i. As per claim 7, Bashoura discloses the claimed invention modified above in claim 1. Furthermore, the modified Bashoura invention teaches:

the terminals comprising a first terminal and a second terminal (inherent that the plurality of terminals comprise at least two terminals).

However, the modified Bashoura invention does not explicitly teach the first terminal being connected to the second terminal via a router. "Official Notice" is taken that both the concept and advantages of connecting terminals via a router are both well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the modified Bashoura invention to include connecting terminals via a router because routers are common network devices used for interconnecting two networks, both commonly using IP addresses.

j. As per claim 8, Bashoura discloses the claimed invention modified above in claim 1. Furthermore, Bashoura teaches:

the image data signal being directly transmitted to the terminal without using a server (nowhere does the modified Bashoura invention teach a server used in data communication, nor is there any reason to inherently expect a server to be used for data transmission).

k. Claim 13 claims similar limitations to claim 8 and is rejected on the same grounds as claim 8.

Art Unit: 2141

3. Claims 2, 10, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. (5,862,202), in view of Stevens (TCP/IP Illustrated), and further in view of Kadowaki (6,674,537).

1. As per claim 2, Bashoura discloses the claimed invention modified above in claim 1. However, the modified Bashoura invention does not explicitly teach anything about one-touch memory buttons. Kadowaki teaches:

a one-touch button memory portion which stores an Internet protocol address in advance (one-touch dialing can store destination network addresses; col. 16, lines 41-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the modified Bashoura invention to include a one-touch button for storing IP addresses in advance, as taught by Kadowaki, for the obvious reason of reducing the number of keystrokes required by a user when entering the destination for a facsimile to be sent.

m. Claims 10, 15, and 19 claim similar limitations to claim 2 and are rejected on the same grounds as claim 2.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Shaw whose telephone number is 703-305-0094. The examiner can normally be reached on Monday - Thursday and alternate Fridays, 7am - 4pm.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharra can be reached on 703-305-4003. The fax

Art Unit: 2141

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph Shaw
Examiner
AU 2141



RUPAL DHARIA
SUPERVISORY PATENT EXAMINER